



HAYES SOLOWAY P.C.
175 Canal Street
Manchester NH 03101

COPY MAILED

OCT 22 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Roger H. Dev et al.
Application No. 10/602,203
Filed: June 24, 2003
Attorney Docket No: NIMESA.1001

This is a decision on the petition filed November 23, 2003, under 37 CFR, requesting that the above-identified application be accorded a filing date of June 24, 2003 with Figure 8 described in the specification and page 24 of the specification as part of the original disclosure.

The petition is **GRANTED, to the extent indicated below.**

On June 24, 2003, the application was filed.

On September 22, 2003, the Office of Initial Patent Examination (OIPE) mailed a Notice to File Missing Parts of Nonprovisional Application stating that the application had been accorded a filing date of June 24, 2003, but that inter alia, Figure 8 described in the specification and Page 24 of the specification appeared to have been omitted from the application. A two (2) month period for reply was set.

In response, on November 23, 2003, the present petition was filed. Petitioner argues that evidence of the submission of page 24 of the specification can be seen in the copy of the original submission of the specification. Additionally, petitioner neither admits or denies that Figure 8 was filed with the original submission. Petitioner argues though that with respect to the submission of page 24 of the specification since it was previously submitted and Figure 8 since it was described in the specification, that neither is new matter and thus entitled to retain the filing date of June 24, 2003 with both as part of the original disclosure.

Petitioner's arguments have been considered, but are not totally persuasive. The U.S. Patent and Trademark Office (Office) file is the official record of the papers originally filed in this application. A review of the papers originally filed reveals that, 13 sheets of drawings were received on June 24, 2003 but that no sheet of drawings containing Figure 8 was filed on June 24, 2003. Further, a review of the papers originally filed indicates that while the Application Transmittal Sheet notes 30 pages of specification being filed upon application, that pages 1-23 representing the specification and pages

25-29 representing the claims and page 30 representing the abstract have been located in the file.

An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence.

It is noted that the USPTO has a long-established and well publicized practice for *prima facie* establishing the date of receipt of correspondence that has either been mailed or otherwise delivered to the PTO, and is asserted to have been subsequently misplaced: the itemized postcard receipt practice of MPEP 503.¹ This practice requires that any paper(s) for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper(s). A postcard receipt which itemizes and properly identifies the paper(s) which is being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. However, due to the absence in the record of a postcard receipt itemized with respect to the drawings and the specification that bears a USPTO date stamp of June 24, 2003, showing that one (1) sheet of drawings containing Figure 8 and a 30 page specification were received in the USPTO on June 24, 2003, the application cannot be accorded a filing date of June 24, 2003, with Figure 8 and page 24 of the specification as a part of the original disclosure.

The only papers present in this file are those received June 24, 2003 and the papers filed with the instant petition on November 24, 2003. Petitioner adds that on August 18, 2003 a substitute specification was filed and submits a copy of an itemized postcard but the postcard is not date-stamped by the USPTO evidencing that the items listed on the postcard were in fact received in the USPTO. However, with the transmittal, petitioners have included a certificate of mail and thus pursuant to 37 CFR 1.8, receipt of the items listed in the letter dated August 18, 2003 can be presumed to have been received on August 18, 2003.

In view of the above, the specification filed August 18, 2003 will be treated as an amendment to the originally filed specification and as a response to the June 24, 2003 Notice. Additionally, in view of the August 18, 2003 filing, the response was timely and the abandonment is avoided since the petition filed November 23, 2003 was filed three months after the response was due.

However, with respect to the apparent omission of Figure 8, it has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).² Since the application was filed with at least one claim

¹ The public was afforded a "reminder" of the then extent post card receipt practice at 857 Off. Gaz. Pat. Off. 667 (O.G.) (Nov. 21, 1968). This specific notice is usually repeated annually, in a January "Consolidated Listing" section of the O.G. that contains important O.G. notices of continuing relevance.

²MPEP 601.01(f).

directed to a process or method, the application should have been treated as an application for which a drawing is not necessary and the Office of Initial Patent Examination should not have indicate that Figure 8 was an omitted Item. See MPEP § 601.01(f).

The application will be processed and examined using the application papers present on June 24, 2003 as well as a copy of the amendment filed August 18, 2003 and resubmitted with the instant petition. However, the drawings submitted with the petition will not be used for processing or examination, but will be retained in the application file. If petitioner should choose that they would like to have the eight (8) drawing sheets included, a separate amendment will need to be filed to have them included.

The Office of Initial Patent Examination will be notified to process the application with a filing date of June 24, 2003, using the application papers filed on that date and the specification filed August 18, 2003 and resubmitted on petition.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

A handwritten signature in black ink, reading "Patricia Faison-Ball". The signature is written in a cursive, flowing style with large, connected letters.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions